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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/673,901	09/28/2003	Patrick W. Smith		1977

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TASER INTERNATIONAL, INC.
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EXAMINER

GREENE, DANIEL LAWSON

ART UNIT PAPER NUMBER

3663

DATE MAILED: 08/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/673,901

Applicant(s)

SMITH, PATRICK W.

Examiner

Daniel L. Greene Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13, 15, 18 and 20-32 is/are pending in the application.
- 4a) Of the above claim(s) 11, 16, 17, 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13, 15, 18 and 20-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/24/05, 7/28/03
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Claims 1-11, 16, 17 and 19 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 6/10/05.

Specification

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

Content of Specification

- (a) Title of the Invention: See 37 CFR 1.72(a) and MPEP § 606. The title of the invention should be placed at the top of the first page of the specification unless the title is provided in an application data sheet. The title of the invention should be brief but technically accurate and descriptive, preferably from two to seven words may not contain more than 500 characters.
- (b) Cross-References to Related Applications: See 37 CFR 1.78 and MPEP § 201.11.
- (c) Statement Regarding Federally Sponsored Research and Development: See MPEP § 310.
- (d) The Names Of The Parties To A Joint Research Agreement: See 37 CFR 1.71(g).

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- (e) Incorporation-By-Reference Of Material Submitted On a Compact Disc: The specification is required to include an incorporation-by-reference of electronic documents that are to become part of the permanent United States Patent and Trademark Office records in the file of a patent application. See 37 CFR 1.52(e) and MPEP § 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text were permitted as electronic documents on compact discs beginning on September 8, 2000.

Or alternatively, Reference to a "Microfiche Appendix": See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.

- (f) Background of the Invention: See MPEP § 608.01(c). The specification should set forth the Background of the Invention in two parts:
- (1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions of the subject matter of the claimed invention. This item may also be titled "Technical Field."
 - (2) Description of the Related Art including information disclosed under 37 CFR 1.97 and 37 CFR 1.98: A description of the related art known to the applicant and including, if applicable, references to specific related art and problems involved in the prior art which are solved by the applicant's invention. This item may also be titled "Background Art."
- (g) Brief Summary of the Invention: See MPEP § 608.01(d). A brief summary or general statement of the invention as set forth in 37 CFR 1.73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.
- (h) Brief Description of the Several Views of the Drawing(s): See MPEP § 608.01(f). A reference to and brief description of the drawing(s) as set forth in 37 CFR 1.74.

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- (i) Detailed Description of the Invention: See MPEP § 608.01(g). A description of the preferred embodiment(s) of the invention as required in 37 CFR 1.71. The description should be as short and specific as is necessary to describe the invention adequately and accurately. Where elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field of the invention described and their exact nature or type is not necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail. However, where particularly complicated subject matter is involved or where the elements, compounds, or processes may not be commonly or widely known in the field, the specification should refer to another patent or readily available publication, which adequately describes the subject matter.
- (j) Claim or Claims: See 37 CFR 1.75 and MPEP § 608.01(m). The claim or claims must commence on separate sheet or electronic page (37 CFR 1.52(b)(3)). Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. There may be plural indentations to further segregate subcombinations or related steps. See 37 CFR 1.75 and MPEP § 608.01(i)-(p).
- (k) Abstract of the Disclosure: See MPEP § 608.01(f). A brief narrative of the disclosure as a whole in a single paragraph of 150 words or less commencing on a separate sheet following the claims. In an international application which has entered the national stage (37 CFR 1.491(b)), the applicant need not submit an abstract commencing on a separate sheet if an abstract was published with the international application under PCT Article 21. The abstract that appears on the cover page of the pamphlet published by the International Bureau (IB) of the World Intellectual Property Organization (WIPO) is the abstract that will be used by the USPTO. See MPEP § 1893.03(e).
- (l) Sequence Listing. See 37 CFR 1.821-1.825 and MPEP §§ 2421-2431. The requirement for a sequence listing applies to all sequences disclosed in a given application, whether the sequences are claimed or not. See MPEP § 2421.02.

2. The disclosure is objected to because of the following informalities: for example, the specification progresses from Background (page 1) to Disclosure of the invention (page 4) to Summary of the invention (page 13).

Appropriate correction is required.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 13, 15, 18 and 20-32 are rejected under the judicially created doctrine of double patenting over claims 12-15 of U. S. Patent No. 6,636,412 to Smith since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: The claims in '412 clearly disclose a method according to applicants instant invention in combination. For example, in the instant application claim 13 mirrors claim 12 of '412 except for specific values which are found in the claims of '412 that are dependant on said claim 12, specifically, claim 13 requires a pulse width from 9 to 100 microseconds and charging provides 0.8 to 10 joules of energy stored per pulse, '412 claims 12 and

14, disclose .9-10 joules and 10-100 microseconds, respectively. Further claims 15 of both patents recite 1 to 3 joules. The limitation 100-500 milliamps is clearly disclosed in section c of claim 12 of '412. Therefore it has been show how the instant application fulfills the requirements of the nonstatutory double patenting rejection.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application, which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

4. Claims 13, 15, 18 and 20-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. Claims 13, 15, 18 and 20-32 are indefinite because they claim both an apparatus (the weapon, capacitor, transformer, pulse, pulse width, pulse magnitude, etc.) and the method steps of using the apparatus (charging, conducting, incapacitating a human target, generating a current, etc.) See MPEP 2173.05(p)

B. Claims 13, 15, 18 and 20-32 are vague, indefinite and incomplete in what all is meant by and encompassed by the limitations, for example, "pulse width", "Joules", "magnitude", "provides", etc. The various limitations fail to specifically define exactly how and in what manner such limitations are determined, including but not limited to measurement points (i.e. where are the values are being measure, including reference values), hence the metes and bounds of the claims are undefined. For example, claim 13 states "wherein the pulse has a pulse width from 9 to 100 microseconds" but fails to state how is this measured or determined. The claim fails to disclose at point the pulse has this limitation or where it is measured.

C. Claim 22 is vague, indefinite, incomplete and so unduly broad as to read on lightening or signal wave generators, which are neither contemplated nor disclosed as part of applicant's invention, hence the metes and bounds of the claim are unascertainable. The limitations "performed by a weapon", "to be conducted through tissue of the target" have not been given patentable weight because they are essentially limitations of intended use, however lightening, signal generators, car batteries, etc. can all be said to have the limitations disclosed and used in the same manner.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

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Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. **Claims 13, 15, 18 and 20-32 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Claims 13, 15, 18 and 20-32 are directed towards neither a "process" nor a "machine" but to both, which overlaps two different statutory classes of invention.

See MPEP 2173.05(p)

Claim Rejections - 35 USC § 102 and 103

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 13, 15, 18 and 20-32 are rejected under 35 U.S.C. 102(b) as being anticipated by NPL provided with applicant's IDS received 6/24/2005, KENNY, John M., "Human Effects Advisory Panel Report of Findings: Sticky Shocker**

Assessment, PennState, Applied Research Laboratory", July 29, 1999, National Criminal Justice Reference Service, Box 6000, Rockville, MD 20849-6000, hereafter Kenny or, in the alternative under 35 U.S.C. 103(a) as obvious over Kenny, in view of any of either U.S. Patent 5,801,617 to Langner et al., U.S. Patent 5,457,579 to Rothschild, U.S. Patent 6,880,466 to Carman or U.S. Patent 5,067,495 to Brehm.

Kenny clearly discloses applicant's invention throughout the entirety of the report.

Kenny also clearly teaches the effects of various alterations of waveforms, power levels, etc., and the motivations for one with common knowledge in the art to make such modifications, see for examples, page 15 Figure 5, page 16 figure 7, page 19, Figure 8, page 21 Figures 9 and 10, page 22 Figure 11, each figures respective explanation on subsequent pages and page D-7 through D-20.

For example, page D-8 Section 3.1, third paragraph clearly discloses a method comprising charging a capacitor and discharging the capacitor through a transformer to generate a pulse, wherein the pulse has a pulse width from 9 to 100 microseconds ((1 to 40 microseconds second paragraph, page D-8) also known in the art as pulse duration, see for example pages D-27 and D-28)) and charging provides .8 to 10 Joules of energy wherein it is understood that converting 10 joules to a current level in milliamps is 100 milliamps of RMS current into a resistance of 1000 ohms for 1 second (see, for example, Page D-12 UL Limit for VF and Page D-17 section 3.2.2.)

It is considered that Kenny clearly discloses all of the various limitations applicant is seeking to patent, however if applicant is of the opinion that Kenny does not disclose the specific limitations recited, then it would have been obvious to one of ordinary skill in the art at the time of the invention to optimize the method of applying electrical current for the desired results (muscle therapy, incapacitation, electroconvulsive therapy, etc.) as taught by the references as being old and well known in the art. See, for example, Langner et al. column 4 lines 44-50 (pulse repetition rate 10-20 pulses per second, 0.1 to 5 joules per pulse), Rothschild, column 4 lines 6-10 (.4347 milliamps, pulse length ~1 millisecond), Carman column 4 lines 57+ and column 5 lines 1-20 (5 to 30 Watts per shock converts to 5 to 30 Joules, pulse repetition rate of 2 to 40 discharges per second, and Brehm, column 1 lines 29-50 and column 5 lines 40-52.

Clearly those in the art of applying electrical shock to the human body are fully aware of the various waveforms and power levels required to perform their intended result. Upon review of the many figures provided in Kenny, it appears that applicant is attempting to claim the entire range of waveforms, including pulse width, frequency, amperage, etc. above all other similar products tested waveforms but below the "Underwriters Laboratory's Upper level Limit of Body Current that induces Ventricular Fibrillation" (see, for example, Page D-13, Figure 1). However it does not seem beyond the knowledge level one of ordinary skill in the art to review the various figures and comments of this report to arrive at the instant invention. See, for examples, Kenny, page 19, Figure 8 and the last

paragraph, "...the subject is unable to release the energized conductor. Tetanus can also be achieved with high current levels", page 22, first paragraph, "The repetition rate and duration of a pulsed stimulus train dictate the magnitude of a subjects physical reaction" and second paragraph "the maximum excitation rate of the motor neurons occurs at about 80 pulses per second", etc.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as showing the current state of the art in applicants field of invention.

10. Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel L. Greene Jr. whose telephone number is (571) 272-6876. The examiner can normally be reached on Mon-Fri 8:30am - 5pm.

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12. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Keith can normally be reached, Mon-Fri 6:30am -4:00pm, at telephone number (571) 272-6878. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DIG

8/21/2005


JACK KEITH
PRIMARY EXAMINER
SE 3663